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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/414,722	10/08/1999	TOMOYUKI NONOMURA	01489/P-2121	3771

7590 02/06/2004

WENDEROTH LIND & PONACK LLP
2033 K STREET N W SUITE 800
WASHINGTON, DC 20006

EXAMINER

LANIER, BENJAMIN E

ART UNIT	PAPER NUMBER
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2132

DATE MAILED: 02/06/2004

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/414,722

Applicant(s)

NONOMURA ET AL.

Examiner

Benjamin E Lanier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 05 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 October 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8,9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Response to Amendment

1. Applicant's cancellation of claims 1-16 and addition of claims 17-48 has been fully considered and is entered.

Response to Arguments

2. Applicant's arguments, see Amendment A, filed 05 December 2003, with respect to the rejection(s) of claim(s) 1-17 under Greenberg have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Maeda, in view of Barton.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 17-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maeda, U.S. Patent No. 5,224,087, in view of Barton, U.S. Patent No. 5,912,972. Referring to claims 17, 19, 29, 33, 35, 45, Maeda discloses an apparatus for recording compressed digital information wherein audio is recorded on a real time basis on a disc-shaped recording medium such as a write once optical disc or an overwritable magneto-optical disc (Col. 3, lines 6-10), which meets the limitations of a stream storage unit and a stream writing unit. Once written on the optical disc, the audio data is capable of being played back (Col. 5, lines 6-11), which meets the

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limitation of a stream reading unit for reading the audio data from the storage unit. The apparatus contains an A/D converter to convert analog audio data to a standard digital audio data format (Col. 6, lines 28-61). Maeda does not disclose that the digital audio data is watermarked upon conversion. Barton discloses a method for embedding authentication information within digital data wherein audio streams (Col. 1, line 25) is embedded with an encrypted digital signature (watermark) (Col. 6, line 55 – Col. 7, line 46). It would have been obvious to embed the digital audio signal of Maeda with a digital signature in the method of Barton because the online distribution of data provides fertile grounds in which piracy and electronic tampering can flourish. This electronic tampering makes it difficult to ensure and police an artists copyrights as taught in Barton (Col. 1, lines 52-58).

Referring to claims 20, 22, 23, 25-28, 36, 38, 39, 41-44, Barton discloses that the data is retrieved by retrieving the embedded information, decrypting the retrieved information, authenticating the digital signature (watermark), decompressing and restoring the original data stream (Col. 7, line 65 – Col. 8, line 27).

Referring to claims 18, 21, 24, 34, 37, 40, Barton discloses that the digital signature could be embedded into the data signal while in analog format (Col. 10, lines 53-63).

Referring to claims 30-32, 46-48, Maeda discloses an apparatus for recording compressed digital information wherein audio is recorded on a real time basis on a disc-shaped recording medium such as a write once optical disc or an overwritable magneto-optical disc (Col. 3, lines 6-10). Once written on the optical disc, the audio data is capable of being played back (Col. 5, lines 6-11).

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin E Lanier whose telephone number is 703-305-7684. The examiner can normally be reached on M-Th 7:30am-5:00pm, F 7:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (703)305-1830. The fax phone number for the organization where this application or proceeding is assigned is 703-746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



THOMAS R. PEESO
PRIMARY EXAMINER